

REMARKS

By this amendment, claims 1, 5, 10-11, and 15-20 have been amended. Claims 12-14 have been canceled. Claims 1-11 and 15-20 are pending in the application. Applicant reserves the right to pursue the original claims and other claims in this and other applications.

Claims 12-14 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter and have canceled. Accordingly, the rejection is now moot.

Claims 1-3, 5-6, 8-9, 11-12, 14-15, 17-18, and 20 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Chan (US 5,271,018). This rejection is respectfully traversed.

Claim 1 recites, *inter alia*, “means for performing a certify process and a verify process with respect to the user data areas and the alternative areas in a predetermined sequence, and selecting an alternative destination for replacing a defective portion, when an error occurs ..., such that an alternative destination is selected from an adjacent alternative area corresponding to the user data area when an unused field exists in the adjacent alternative area, and such that the alternative destination is selected from another alternative area on which the certify process and the verify process have already been performed according to the predetermined sequence in the case where an unused field does not exist in the adjacent alternative area” (emphasis added). Applicant respectfully submits that Chan does not disclose these limitations.

Claim 5 recites, *inter alia*, “a formatting part that performs a format process with respect to the user data areas and the alternative areas in a predetermined sequence; a

defect field detection part that detects a defect field at the time of a format process or recording of information before the format process is completed with respect to all the user data areas and all the alternative areas; a first usable field determination part ...; and a first alternative field assigning part that assigns, when said first usable field determination part determines that the alternative field does not exist, ... an alternative field in another alternative area to which the format process has already been performed according to the predetermined sequence" (emphasis added). Claims 5, 11, 15, 17-18, and 20 recite similar limitations. Applicant respectfully submits that Chan does not disclose these limitations.

To the contrary, Chan discloses that "each partition consists of 16 data sectors and one spare sector for a total of 17 sectors per partition." Col. 6, ln. 62-64. Chan further discloses that "[e]ach partition has at least one local sector at the end of the partition." Col. 7, ln. 1-2 (emphasis added). Chan discloses dividing the recording area into a plurality of zones and providing a plurality of partitions in each zone. Each partition has at least one spare sector at the end of the partition. Each zone has a number of overflow spare sectors at the end of the zone. If there is a defective sector in a partition, the spare sector of this partition is used to replace the defective sector. If the spare sector of this partition is already used, an overflow spare sector is used to replace an additional defective sector.

It should be noted that Chan is not directed to a situation in which a portion that is certified and verified coexists with a portion that is neither certified nor verified. Specifically, Chan does not take into account a situation in which an error occurs during the certify process or verify process performed with respect to a user data area. It thus follows that Chan does not disclose selecting an alternative destination for replacing a defective portion when an error occurs during the certify process or verify process performed with respect to a user data area, as recited in claims 1, 5, 11, 15, 17-18, and 20.

Further, Chan does not disclose selecting the alternative destination from another alternative area on which the certify process and the verify process have already been performed according to the predetermined sequence in the case where an unused field does not exist in the adjacent alternative area, as recited in claims 1, 5, 11, 15, 17-18, and 20.

Since Chan does not disclose all of the limitations of claims 1, 5, 11, 15, 17-18, and 20, claims 1, 5, 11, 15, 17-18, and 20 are not anticipated by Chan. Claims 2-3, 6, 8-9, 11, 15, 17-18, and 20 depend, respectively, from independent claims 1, 5, and 11, and are patentable at least for the reasons mentioned above, and on their own merits. Claims 12 and 14 have been canceled. Applicant respectfully requests that the 35 U.S.C. § 102(b) rejection of claims 1-3, 5-6, 8-9, 11-12, 14-15, 17-18, and 20 be withdrawn and the claims allowed.

Claim 4 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Chan in view of Gotoh et al. (US 6,292,625). This rejection is respectfully traversed. Claim 4 depends from claim 1 and is patentable at least for the reasons mentioned above, and on its own merits.

Moreover, the Supreme Court recently said in *KSR Int'l Co. v. Teleflex Inc.* that "the [Graham] factors continue to define the inquiry that controls" a finding of obviousness and reiterated that a "patent composed of several elements is not proved obvious merely by demonstrating that each element was, independently, known in the prior art." 127 S. Ct. 1727, 1734 (U.S. 2007). The Graham factors include determining the scope and content of the prior art, ascertaining differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art. *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).

Applicant submits that the Office Action has not properly shown that the Applicant's claims would have been obvious by conducting an examination of the Graham factors. "Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case." M.P.E.P. § 2141. Instead, to show that Chan and Gotoh et al. may be properly combined and that the Applicant's claims are obvious in light of these references, the Office Action merely stated that it would be obvious to combine Gotoh et al. with Chan "to maintain real time recording and continuous reproducing of the data." Office Action at p. 11. This unsupported statement is not an adequate substitution for an analysis of the Graham factors and does not show obviousness.

Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claim 4 be withdrawn and the claim allowed.

Claims 7, 10, 13, 16, and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Chan in view of Ueda et al. (US 2003/0137910). This rejection is respectfully traversed. Claims 10, 16, and 19 recite limitations similar to claims 1, 5, 11, 15, 17-18, and 20; therefore, Ueda et al. does not cure the above-discussed deficiencies of Chan. Claim 7 depends from claim 5 and is patentable at least for the reasons mentioned above, and on its own merits. Claim 13 has been canceled.

Moreover, Applicant submits that the Office Action has not properly shown that the Applicant's claims would have been obvious by conducting an examination of the Graham factors. "Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case." M.P.E.P. § 2141. Instead, to show that Chan and Ueda et al. may be properly

combined and that the Applicant's claims are obvious in light of these references, the Office Action merely stated that it would be obvious to combine Gotoh et al. with Chan "to create a continuous recording/reproducing process." Office Action at p. 12. This unsupported statement is not an adequate substitution for an analysis of the Graham factors and does not show obviousness.

Applicant respectfully requests that the 35 U.S.C. § 103(a) rejection of claims 7, 10, 13, 16, and 19 be withdrawn and the claims allowed.

In view of the above, Applicant believes the pending application is in condition for allowance.

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Respectfully submitted,

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